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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/552,881	07/17/2006	Simone Charlotte Vonwiller	ALAR8.001 APC	9163
20995 7590 09/05/2008 KNOBBE MARTENS OLSON & BEAR LLP 2040 MAIN STREET FOURTEENTH FLOOR IRVINE, CA 92614				
EXAMINER				
PALENIK, JEFFREY T				
ART UNIT		PAPER NUMBER		
1615				
NOTIFICATION DATE		DELIVERY MODE		
09/05/2008		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

jcartee@kmob.com  
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# Office Action Summary

**Application No.**

10/552,881

**Applicant(s)**

VONWILLER ET AL.

**Examiner**

Jeffrey T. Palenik

**Art Unit**

1615

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 19 February 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 36-50 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 36-50 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 October 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-8508)  
Paper No(s)/Mail Date 2 Jan 2007
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Remarks***

The Examiner thanks Applicants for the timely reply filed 19 February 2008, in the matter of 10/552,881.

Applicants' election **without traverse** of Group I, claims 36-50, in the reply filed on 4 February 2008 is acknowledged. The Examiner thanks Applicants for pointing out the typographical error to Group I, which inadvertently omitted claim 36 from the group. Applicants' election **without traverse** of the species hyaluronic acid is also acknowledged.

The remaining claims of Group II (51-60), Group III (61-62), and Group IV (63-66), are hereby withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim.

The remaining claims 36-50 are presented and represent all claims under consideration.

### ***Information Disclosure Statement***

An Information Disclosure Statement (IDS), filed 02 January 2007 is acknowledged and has been reviewed.

### ***Drawings***

The drawings are objected to under 37 CFR 1.83(a) because they fail to clearly show data and information (i.e. difficult to read), which is described in the specification. Any structural detail that is essential for a proper understanding of the disclosed invention

should be shown in the drawing. MPEP § 608.02(d). Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 36-50 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Step (c.) of the independent claim 36 recites an “optional” washing step. The recitation of the term “optional” renders the claim indefinite because it is unclear as to whether or not the washing step which follows is part of the claimed invention. Herein, and for the purposes of examination on the merits, the Examiner broadly and reasonably interprets the claim as including the optional washing step.

The limitation to the polysaccharide component of the instant invention as recited in claim 38 is indefinite because it is not clear whether the term “anionic derivative of” extends to all of the species in the claim (i.e. including the elected hyaluronic acid) or only to the species immediately following the phrase (i.e. carboxymethyl cellulose). Given Applicants’ election of the species hyaluronic acid without traversal, the Examiner interprets the claim such that the term “anionic derivative of” extends only to carboxymethyl cellulose.

The remaining claims are rejected as being dependent from the above rejected claims.

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 36-41, 46 and 47 are rejected under 35 U.S.C. 102(b) as being anticipated by Zhao (WO 00/46253).

The instant claims are directed to a process for producing a cross-linked gel comprising mixing (e.g. contacting) an alkaline-based polysaccharide medium with an epoxide cross-linking agent via ether bonds, drying said gel without removing the ether bonds, washing the gel with a water miscible solvent and neutralizing said gel using an acidic medium (claim 1). The polysaccharide is further recited as hyaluronic acid or (HA) (claims 37-39). The epoxide is further recited as butanediol diglycidyl ether (claims 40 and 41). The mixing, drying and washing steps are recited as being performed under alkaline conditions with acetone (claims 46 and 47).

Zhao teaches a method for producing a cross-linked gel wherein an alkaline solution of hyaluronic acid in sodium hydroxide is mixed with varied volumes of the multifunctional epoxide 1,2,7,8,-diepoxyoctane, drying said mixture into a gel formation, purifying (e.g. washing) the dried gel using acetone/water, acetone and isopropyl alcohol (IPA), and neutralizing said gel in an acidic medium of acetone/hydrochloric acid at pH 5 (Example 6 and claim 1). Claim 4 teaches additional cross-linking agents such as butanediol diglycidyl ether.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 36-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zhao (WO 00/46253) in view of Mälson (WO 87/07898).

The instant claims are directed to a process for producing a cross-linked hyaluronic gel, as discussed above. Various conditions under which the procedure is performed such as pH (claim 42), component concentration (claim 43), and reaction and drying temperatures (claims 44 and 45) are recited. Claims 48 and 49 recite step (d.) as further comprising freeze-drying or lyophilizing the produced gel and reconstituting it in phosphate buffered saline (PBS). The term “reconstituting”, viewed in its broadest and most reasonable terms, is interpreted by the Examiner as reciting “restoration to a former condition by adding water”. In the case of claim 49, this is interpreted as restoration using a water-based medium such as PBS. Claim 50 recites the gel as further comprising a biologically active substance.

The teachings to Zhao are discussed above. Zhao further teaches that the starting solution for an alkaline solution is preferably at a pH of 10 or more and that the reaction may effected at a temperature in the range of 15 to 50°C (pg. 9, line 27 to pg. 10, line 4). Example 6 further teaches that the starting solution is a 2.5% solution of hyaluronic acid in

sodium hydroxide (HA/NaOH) which is mixed with varying amounts of epoxide. Tables 1-3 teach varying “feeding ratios” of HA to the cross-linking compound. Drying of the gel at a temperature of at least about 35°C (i.e. in a 37°C oven) is taught (Examples 1-3). Restoration of the gel product from a dried film or sheet format by immersing it in PBS is taught (pg. 11, lines 11-15). Incorporation of a biologically active substance into the gel is taught (claims 1, 15, 22 and 23).

Freeze drying as a means for drying the gel to a film or sheet format is not expressly taught by Zhao. Nor is it expressly taught that the gel is dried under a vacuum.

Mälson teaches the preparation of a cross-linked polymerized gel product (e.g. an insoluble, porous spongy material) wherein sodium hyaluronate or hyaluronic acid is dissolved into sodium hydroxide, mixed with 0.15 wt./volume % butanediol diglycidyl ether (BDDE), washed (e.g. dialysed) with water and then dried to form the film under acidic conditions (Example 1 and claims 1-7). Example 9 expressly teaches drying the formulation using freeze-drying. Example 19 teaches incorporation of Vitamin A as a biologically active substance which is controllably released from said gel by immersion into a volume of buffer. “Physiological saline” such as PBS is taught as being used to swell or restore the gels (pg. 9, second paragraph; pg. 8, bottom paragraph).

Mälson does not expressly teach the steps of the method in order or all of the specific reaction conditions as instantly claimed (e.g. vacuum drying).



In view of the combined teachings of the prior art, one of ordinary skill in the art, at the time of the invention, would have been motivated to use the instantly claimed method in order to prepare a hyaluronic acid and epoxide cross-linked polymerized gel. Such would have been obvious in the absence of evidence to the contrary since Zhao expressly teaches the procedure with the exception of certain particular claimed parameters (i.e. compositional epoxide percentage, vacuum drying, or freeze-drying). With the exception of certain adjustable parameters, the art taught by Mälson overlaps in its teaching of method steps (e.g. alkaline starting solutions mixed with epoxides) and components (e.g. hyaluronic acid and butanediol diglycidyl ether) with Zhao, both of which can be incorporated to arrive at the instant method claims. Lyophilization, while not taught by Zhao, is a method which is well known in the art by the skilled artisan as a means for preserving gels as dehydrated films. Furthermore, though neither of the practiced inventions expressly teach using a drying the gel preparations at higher temperatures using a vacuum drying oven, one of ordinary skill in the art would be well motivated to employ such an oven if for no other reason than to minimize the risk of particulate contamination in the dried gel product.

Therefore, a person of ordinary skill in the art would have a reasonable expectation of success in modifying the gel-producing method practiced by Zhao with the freeze-drying gel preparation step taught by Mälson since the combined teachings disclose the instantly claimed method for producing a biologically active cross-linked gel composition. Therefore, the invention as a whole would have been *prima facie* obvious to one of ordinary skill in the art at the time of the invention.

While neither Zhao nor Mälson teach the instantly claimed pH, temperature and percentage ranges, as instantly claimed by Applicants, Zhao offers a broader teaching of said parameters in the practiced Examples and Tables, as discussed above. Since the values and formats of each parameter with respect to the claimed composition are adjustable, it follows that each is a result-effective parameter that a person having ordinary skill in the art would routinely optimize. Optimization of parameters is a routine practice that would be obvious for a person of ordinary skill in the art to employ. As evidenced by the combination of the two teachings, it would have been customary for an artisan of ordinary skill, for example, to adjust the amount of multifunctional epoxide-based cross-linking agent, in order to achieve the desired gel composition. Thus, absent some demonstration of unexpected results from the claimed parameters, optimization of any of these parameters would have been obvious at the time of Applicants' invention.

### *Correspondence*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey T. Palenik whose telephone number is (571) 270-1966. The examiner can normally be reached on 7:30 am - 5:00 pm; M-F (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward can be reached on (571) 272-8373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published

applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jeffrey T. Palenik/  
Examiner, Art Unit 1615

/MP WOODWARD/  
Supervisory Patent Examiner, Art Unit 1615